PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number A2507-US-NP
	Application Number 10/802,213 Filed March 17, 2004
	First Named Inventor Steven F. Livengood
	Art Unit 2625 Examiner I. Cruz
	Confirmation Number 3559

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor. Signature /Duane C. Basch, Esq. Reg. No. 34,545/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. Typed name **Duane C. Basch**

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☐ Registration number if acting under 37 CFR 1.34 Date January 20, 2011

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*
Total of forms are submitted.

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Arguments in Support of Request for Pre-Appeal Review

Applicants respectfully submit the following argument in traversal of the rejection of claims 1-5 under 35 U.S.C. §103(a) as being unpatentable over Herron (US 2005/0157921) in view of Tagami et al. (US 5,237,425; "Tagami").

Arguments in Support of Withdrawal of Rejection

In the Advisory Action dated Dec. 21, 2010, the Examiner continued rejection of claims 1-5 under 35 U.S.C. §103(a) as being unpatentable over Herron in view of Tagami, Applicants respectfully submit the following arguments in traversal of the outstanding rejection for consideration by the conferees. Considering independent claim 1, Applicants continue to submit that the rejection fails to set forth *prima facie* obviousness.

As previously noted by Applicants, the rejection fails to properly support the basis alleged for the combination. Considering the basis for the alleged combination (see pp. 4-5 of final office action), at best the basis is merely a recitation of Applicants' claim language, rather than an independent assessment of what one of skill in the art would have been motivated to do. The basis for combination improperly relies on Applicants' claim language, and as such can only demonstrate that the Examiner has engaged in hindsight reconstruction. Applicants respectfully submit that pursuant to MPEP §2141, "[o]bviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

(A) Determining the scope and content of the prior art; and

(B) Ascertaining the differences between the claimed invention and the prior art; and

(C) Resolving the level of ordinary skill in the pertinent art." (MPEP §2141, *citing KSR, 550 U.S. 287, 82 USPQ2d 1385, 1391 (2007) and Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)*. It is only after the Examiner has established the Graham factual findings and concluded that the claimed invention would have been obvious that the burden shifts to the Applicant to show an error or to provide other evidence of nonobviousness. As is apparent from a review of the Final Office Action dated Sept. 21, 2010 ("Final Action"; particularly pp. 3 – 5) the rejection fails to address the required inquiries. For example, no indication was made of the level of skill in the pertinent art or the scope and content of the prior art. Lacking the required analysis, withdrawal of the rejection is respectfully requested for failure to provide a basis to establish that the alleged combination was obvious.

Even if considered, *in arguendo*, the combination of Herron and Tagami fails to set forth all the limitations recited in claim 1. As previously acknowledged by the Examiner, in the Office Action dated

> Tagami'425 fails to show a method determining, from the two-color input data, a rendering characteristic for each of the primary color and the secondary color; based upon the rendering characteristics, and the primary and secondary colors, representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output; and processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space.
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> **(Office Action dated June 24, 2008, Ex. I. Cruz, p. 3)**

The Examiner now contends that "newly supply arguments regarding previous stance" (Final Office Action, p. 2) have been provided and further urges that Tagami teaches the limitations previously acknowledged as missing from Tagami. Applicants respectfully urge that the Examiner has again failed to address Applicants' outstanding request that the Examiner identify, on the record, why the contradictory interpretation of Tagami is now applicable in order to permit Applicants to respond accordingly.

Instead, the Examiner continues to allege that Tagami now teaches "determining, from the two-color input data, a rendering characteristic for each of the primary color and the secondary color; based upon the rendering characteristics, and the primary and secondary colors, representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output; and processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space" as set forth in claim 1. More specifically, the Examiner contends that determining a rendering characteristic for each of the primary color and the secondary color from the two-color input data is taught by Tagami. The rejection alleges that such a limitation is taught by "a two color input data from like the ones needed in highlight printers ((duotone)) need a Ink source Language where the user defines his colors ((like for example the duotone colors)) and the output is define by the colors and screens/rendering- characteristic. See Column 1, Lines 16-35 and 39-55, See Column 3, Lines 15-27 and 55-66)." The referenced background text in col. 1 describes the use of a highlight color in printing whereas the text of col. 3 is directed to the description of Fig. 1, and the header of an Ink Catalog. Applicants respectfully urge that a general discussion of highlight color printing and the format of an ink catalog header fails to disclose determining a rendering characteristic for each of the primary color and the secondary color from the two-color input data as required by independent claim 1. Notably, the Advisory Action fails to address this distinction.

Next, the Examiner alleges that representing a combination of the primary and secondary colors, and the associated rendering characteristics, as an intermediate output, based upon the rendering

characteristics, and the primary and secondary colors is also taught by Tagami. This is alleged to be described by a screen set definition ((SCNSET)) at column 5, lines 3-23 and 33-42, column 6, lines 29-67, column 7, lines 1-42, column 8, lines 36-67, column 12, lines 12-55, and column 15, lines 60-67. Applicants respectfully maintain that, having failed to identify where Tagami teaches determining a rendering characteristic for each primary color, reliance on Tagami to teach further limitations that require the rendering characteristics would also be unsupported. As for col. 5, the teachings appear to be related to a palette structure (Fig. 5) and screen set pattern. Even if the Examiner's interpretation that the parenthetical mention of "screen" rises to the disclosure of a rendering characteristic, there is still no suggestion of its use to represent a combination of the primary and secondary colors as an intermediate output, based upon the rendering characteristics, as recited in claim 1.

Column 6, lines 29-67 of Tagami refer to a texture directory and its organization as depicted in Fig. 9, and describes textures within a palette. Once again, Applicants respectfully submit that such a teaching fails to disclose a rendering characteristic for each primary color, nor their use to represent a combination of the primary and secondary colors as an intermediate output, based upon the rendering characteristics. As for column 7, lines 1-42, this is a continuation from the end of Column 6 and relates to the description of Fig. 10, the SCNSET definition, and includes the number of definitions, maximum distance, percentages of black and highlight color. The balance of Column 7 is directed to the description of Fig. 11, a screen definition. Again, neither Figs. 10 or 11, nor the discussion thereof result in a teaching of a rendering characteristic for each primary color, nor a suggestion of their use to represent a combination of the primary and secondary colors as an intermediate output, based upon the rendering characteristics as recited in claim 1.

Tagami is further urged as teaching the limitations of claim 1 at column 8, Lines 36-67. The cited portions of Column 8 are directed to a description of Fig. 13, which is a color definition. Here, the color definition is described as including an index for two primaries, although one may be zero if only one primary is used in the color. Character words are used to reference or locate the bitmaps for the color, as well as an offset to a screen to be used for the color. No teaching is believed to be found for the recited rendering characteristics for each primary color, or use to represent a combination of the primary and secondary colors as an intermediate output, based upon the rendering characteristics. Column 12, lines 12-55, describe an ink compiler, "a non-print time, stand alone utility that allows a user to create specific inks that can be used on the printer system" (column 12, lines 13-16). Applicants continue to maintain that such a disclosure fails to teach the recited limitations, and that the teaching of an ink compiler would appear to be contrary to the intent and claims of the instant application (e.g., claim 1, "method for converting input data representing a color formed from only two primary colors to output data representing a color in a full color space) as well as Herron. Applicants respectfully submit that such teachings by Tagami are further indicia that the rejection improperly seeks to combine the disclosures.

Lastly, at column 15 of Tagami, lines 60-67 are directed to defining screens or a screenset, which is taught to be a collection of halftone screens. Applicants once again maintain that the teaching of screens or sets of screens does not give rise to the teaching of a rendering characteristic for each primary color, nor a suggestion of their use to represent a combination of the primary and secondary colors as an intermediate output, based upon the rendering characteristics, as recited in claim 1. In view of the examples above, among others, that illustrate the failure of Tagami to teach limitations that it has been relied upon in the rejection, the rejection itself is improper relative to claim 1 and should be withdrawn.

Applicants further contend that processing the intermediate output using a second function to generate the output data representing a single color defined in the full color space is also not taught by Tagami, column 7, lines 43-67, column 9, lines 39-67, column 14, lines 15-43, or otherwise. Hence, the final limitation of claim 1 is also not taught by Tagami.

Accordingly, on its face, the current rejection again fails to establish *prima facie* obviousness as the Examiner has acknowledged that Herron (Current Action, p. 5) and Tagami (June '08 Action, p. 3) both fail to teach that limitation. Alternatively, those portions of Tagami now alleged as teaching the previously acknowledged omissions, likewise fail to teach the specific limitations of independent claim 1, and specific examples have been provided herein. Whether considered alone or in combination, Herron and Tagami fail to teach all of the limitations set forth in independent claim 1. Hence the rejection is traversed, and claim 1 is respectfully urged to be in condition for allowance. Withdrawal and immediate indication of allowance is respectfully requested.

As for dependent claims 2-5, these claims all depend from now presumably allowable claim 1 and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to independent claim 1.

Furthermore, relative to claim 2, the claim requires that the first mapping function be user defined. The rejection alleges that such a limitation is found in Herron at Para. 19 – 23). While Herron does reference a user selecting files, Applicants cannot find reference to a user-defined function, let a lone a mapping function as set forth in claim 2. In view of the noted distinction, claim 2 is urged as separately distinguishable over the arguable combination of Tagami and Herron. Claim 3 further builds on claim 2 and requires that "the user-defined function is a user-defined map from a highlight-color space to full-color space." Again, the selection of a file is not believed to give rise to the limitations as expressly set forth in the rejected dependent claim. For this reason, claim 3 is also urged as patentably distinguishable over Tagami and Herron, both alone or in arguable combination.

Claim 4, dependent from claim 1, requires converting the secondary color into an HSV representation and applying the percentage of highlight to the HSV representation. HSV (see

para. 0030) refers to hue, saturation and value representation and Applicants are unable to find such a representation taught or suggested in Tagami as has been alleged as the basis for the rejection. Absent such a disclosure the rejection must be withdrawn as failing to set forth *prima facie* obviousness. Claim 5, dependent from claim 4, further requires applying a percentage black to the intermediate value and then converting the intermediate value to a full-color representation using a programmatic function. In addition to the arguments relative to claim 4, no such teaching is found in Tagami or Herron. Contrary to the Examiner's contention, neither Herron nor Tagami teach the recited limitation. Moreover, the rejection appears to indicate that the "color space can be used to define the desired color" (Final Action, p. 6). Applicants further note that on its face the rejection is improper as it is merely unsupported conjecture and fails to establish what would have been obvious to one of ordinary skill in the art as required under *Graham v. Deere* as noted above. Withdrawal of the rejection of claims 4 and 5 is also respectfully requested.

The conferees' review of the pending application, particularly in view of the foregoing remarks, and withdrawal of the rejections of claims 1 - 5 are earnestly solicited.

Respectfully submitted,

/Duane C. Basch, Esq. Reg. No. 34,545/